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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,399	03/22/2000	Maria Gabriclla Santoro	10167-004-999	9404

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EXAMINER

TRAVERS, RUSSELL S

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/533,399**

Applicant(s)  
**Santoro et al**

Examiner  
**Russell Travers**

Art Unit  
**1617**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 14, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-17, and 22-33 is/are pending in the application.
- 4a) Of the above, claim(s) 1-4 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5, 7-9, 12-17, and 22-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4, 7 20) ☐ Other:

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The amendment filed December 14, 2001 has been received and entered into the file.

*Ready 57, 34-57*

Claims 1-9, 12-17 and 22-33 are presented for examination.

Applicant's election with traverse of Group IV, claims 5, 7-9, 12-17 and 22-33 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that some specified groups differ by only one claim. This is not found persuasive because the additional claim recites a utility distinct from those utilities set forth in the elected group.

The requirement is still deemed proper and is therefore made FINAL.

Accordingly, claims 1-4 and 6 are withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. § 1.142(b) and M.P.E.P. § 821.03.

*112 P 2 - 36, 37-39, 40-46, 47-57*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

*OK OK 36-38*  
Claims ~~5, 7-9, 12~~ and ~~22~~ are rejected under 35 U.S.C. § 102(b) as being

anticipated by Amici et al, or Noyori et al, or Del Soldato..

Applicants' attention is directed to *Ex parte Novitski*, 26 USPQ2d 1389 (BOPA 1993) illustrating anticipation resulting from inherent use, absent a *haec verba*

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recitation for such utility. In the instant application, as in *Ex parte Novitski*, supra, the claims are directed to preventing a malady or disease with old and well known compounds or compositions. It is now well settled law that administering compounds inherently possessing a protective utility anticipates claims directed to such protective use. Arguments that such protective use is not set forth *haec verba* are not probative. Prior use for the same utility clearly anticipates such utility, absent limitations distancing the proffered claims from the inherent anticipated use. Attempts to distance claims from anticipated utilities with specification limitations will not be successful. At page 1391, *Ex parte Novitski*, supra, the Board said "We are mindful that, during the patent examination, pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). As often stated by the CCPA, "we will not read into claims in pending applications limitations from the specification." *In re Winkhaus*, 52 F.2d 637, 188 USPQ 219 (CCPA 1975)". In the instant application, Applicants' failure to distance the proffered claims from the anticipated prophylactic utility, renders such claims anticipated by the prior inherent use.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 5, 7-9, 12-17 and 22-33 are rejected under 35 U.S.C. § 103 as being unpatentable over Amici et al, Noyori et al and Del Soldato, newly cited, or of record.

Ohno et al (EW)  
Schroer et al 97:193728, Konturek et al 98:4764P  
Amici et al, Noyori et al and Del Soldato teach the claimed compounds as old 98:12130

and well known in combination with various pharmaceutical carriers and excipients in a dosage form. These medicaments are taught as useful for providing cytoprotection, viewed by the skilled artisan as indistinguishable from those uses herein claimed.

Claims 13-17 and 23-33, and the primary references, differ as to:

- 1) the recitation of proposed biochemical action mediating the therapy,
- 2) recitation of patients possessing numerous diseases, and
- 3) recitation of specific compounds.

The instant claims are directed to effecting a biochemical pathway with an old and well known compound. Arguments that Applicant's claims are not directed to the old and well known ultimate utility for this compound are not probative. It is well settled patent law that mode of action elucidation fails to impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re

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Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter, may in fact be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. In the instant invention, the claims are directed to the ultimate utility set forth in the prior art, albeit distanced by various biochemical intermediates. The ultimate utility for the claimed compounds is old and well known, rendering the claimed subject matter obvious to the skilled artisan. It would follow therefore that the instant claims are properly rejected under 35 USC 103.

Attention is directed to the instant claims reading on a cytoprotective utility. The skilled artisan would treat patients requiring cytoprotection, with cytoprotective agents, regardless the absence, or presence of additional etiological agents, or maladies. Claims 5, 7-9, 12-17 and 22-33 read on a cytoprotective utility, not another unrelated therapeutic regimen. Applicant should take care to maintain distance from other unrelated utilities.

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The skilled artisan, possessing a compound for a therapeutic use possesses that compound's homologs, analogs, isomers and bioisosteres; to include all salts, acids and esters. In the instant case, the claimed compounds are old and well known therapeutic agents, rendering pharmaceutical compositions containing these old therapeutic agents obvious.

No claims are allowed.

Any inquiry concerning this communication should be directed to Russell Travers at telephone number (703) 308-4603.

A handwritten signature in black ink, appearing to read 'RT', with a long horizontal stroke extending to the right.

**Russell Travers  
Primary Examiner  
Art Unit 1617**